

Docket No.: 49784DIV(71417)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kenneth Walsh

Application No.: 10/713,678

Confirmation No.: 2909

Filed: November 14, 2003

Art Unit: 1651

For: HMG CoA REDUCTASE INHIBITORS FOR
PROMOTING ANGIOGENESIS

Examiner: L. E. Baumhart

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RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed August 11, 2005, applicant hereby provisionally elects claims 1, 3-29 for continued examination, with traverse.

The Examiner has required restriction between:

Group I: which includes claims 1 and 3-29, directed to methods for promoting angiogenesis in a tissue of a subject;

Group II: which includes claim 2, directed to methods for treating a subject in need of increased blood flow to a tissue;

Group III: which includes claims 30-41, directed to methods for activating an Akt polypeptide;

Group IV: which includes claims 42-49, directed to methods for promoting angiogenesis;

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Group V: which includes claims 50-52, directed to screening methods to identify an Akt activating compound; and

Group VI: which includes claims 53-62, directed to methods for treating a wound.

In response to the restriction requirement set forth in the Office Action mailed August 11, 2005, applicant hereby provisionally elects the invention of Group 1, claims 1 and 3-29 for continued examination. In addition, the Office further requires election of a species of conditions as set forth in claim 4; a species of statins as set forth in claim 7; a mode of administration as set forth in claims 8 and 9; a formulation as set forth in claim 15; a growth factor as set forth in claim 20; and an Akt protein as set forth in claim 24. In response, applicant elects each of the following species: the condition is limb ischemia; the statin is simvastatin; the mode of administration is oral; the formulation is a gel; the growth factor is acidic fibroblast growth factor; and the Akt protein is Akt 1. Applicant respectfully traverses the requirements for restriction and election, and submit that the requirements are improper.

First, the subject matter of these groups relates to a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences, which merit examination of all of these claims in a single application. More particularly, a single, searchable, unifying aspect links all of the claims. This single, searchable, unifying aspect relates to the promotion of angiogenesis using HMG coA reductase inhibitors.

Second, applicant submits that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (8th ed., Rev. No. 2, May 2004). That is, even if the above-enumerrated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden. This is especially true given that all three groups of claims share the same class and subclass (514, subclass 460, respectively), and given the robust and extensive computerized search engines

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and databases at the Examiner's disposal. Accordingly, it is respectfully requested that the restriction requirement be reconsidered and the elected claims of Group I be rejoined with those of Groups II-IV, so that claims 1-62 may be presently examined.

This response is being mailed together with a Petition for an Extension of Time for three months. Applicant notes that the Office Action was mailed on August 11, 2005; and the petition extends the period for reply to Monday, December 12, 2005, because December 11, 2005 was a Sunday.

Applicant believes that no additional fee is required to consider this response. If any additional fee is due, please charge our Deposit Account No. 04-1105.

Dated: December 12, 2005

Respectfully submitted,

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